

RECEIVED
CENTRAL FAX CENTERREMARKS

NOV 02 2006

Election/Restrictions

Claims 21-67 have been withdrawn from consideration as being drawn to a non-elected invention and species of the invention. The Applicant has cancelled claims 21-67 without prejudice for possible submission in a continuing application.

Claim Rejections – 35 USC §102 and §103

Claims 1-5, 10-14, and 19-20 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,235,028 to Brumfield et al. (hereafter “the ‘028 reference”). Additionally, claims 6-9 and 15-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘028 reference in view of U.S. Patent No. 6,589,244 to Sevtrain et al. (hereafter “the ‘244 reference”).

Rejection of Independent Claim 1 and Dependent Claims 2-9

As indicated above, independent claim 1 has been rejected as being anticipated by the ‘028 reference. “[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In order to more clearly define the present invention, claim 1 has been amended and now recites that “said guiding portion is flexible and positionable between an untaut configuration and a taut configuration as the implant is guided therealong.” Support for the amendment to claim 1 may be found, for example, in ¶ 34 of the specification of the application. The Applicant submits that the features recited in amended claim 1 are not disclosed by the ‘028 reference and therefore respectfully submits that claim 1 is patentably distinguishable thereover. Accordingly, withdrawal of the rejection of claim 1 is respectfully requested.

Additionally, claims 2-9 depend from independent claim 1 and are patentable for at least the reasons supporting the patentability of independent base claim 1. Moreover, in regard to the 35 U.S.C. § 103 rejection of dependent claims 6-9, the Applicant submits that in order for an obviousness rejection to be proper, the combination of prior art references must teach or suggest

Response to non-final Office Action
Application Serial No. 10/645,457
Page 8 of 11

all the claim limitations. Manual of Patent Examining Procedure (MPEP) §2142 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The features of amended claim 1 which are novel over the '028 reference are also not taught or suggested by the '244 reference. Therefore, the combination of references fails to teach or suggest all of the claim limitations of claims 6-9 depending from claim 1.

Additional reasons support the patentability of at least dependent claims 7-9. For example, claim 7 recites that the distal extensions include an engagement portion extending therefrom engageable with the bone anchor. It is respectfully submitted that posts 112, 114, 212, 214 of the '244 reference do not include an engagement portion extending therefrom. In fact, as the posts 112, 114, 212, 214 are complementary in size to openings 132, 134, (see column 10, lines 25-26) there would be no need to include an engagement portion extending therefrom. Claim 8 further defines the engagement portions as projecting laterally from each respective distal extension. Assuming only *arguendo* that the '244 reference even discloses engagement portions extending from the distal extensions, it is submitted that they would not project laterally from the distal extensions. In fact, in all but one form the posts 112, 114, 212, 214 are formed by a cylindrical body having a smooth circumferential exterior. In the embodiment illustrated in Fig. 13a, post 212 includes a coil spring or O-ring 215 which may extend beyond the circumferential exterior of the rest of post 212, but it projects therefrom radially, not laterally. Moreover, since the posts 112, 114, 212, 214 and openings 132, 134 are structured for frictional engagement, adding engagement portions which laterally project from the posts would merely add manufacturing costs while decreasing the security of the frictional engagement. Furthermore, claim 9 recites that the distal extensions are deflectable toward one another for insertion into the bone anchor. This feature is not taught or suggested by the '244 reference. In fact, such a feature is not necessary for engagement of the posts 112, 114, 212, 214 with openings 132, 134 as the '244 reference specifically indicates (column 10, lines 25-27) that the posts and openings are located complementary to one another. Therefore, the posts need not be deflectable toward one another for insertion into the anchor. Additionally, since the posts 112, 114, 212, 214 and openings 132, 134 are complementary sized, making them deflectable toward one another would likely create insertion difficulties. Accordingly, these dependent claims are further submitted as patentable over the cited references.

Response to non-final Office Action
Application Serial No. 10/645,457
Page 9 of 11

RECEIVED
CENTRAL FAX CENTER

NOV 02 2006

Rejection of Independent Claim 10 and Dependent Claims 11-20

Independent claim 10 has been rejected as being anticipated by the '028 reference. In order to more clearly define the present invention, claim 10 has been amended and is now directed to a device for guiding an implant to a location adjacent a bone anchor, comprising a guide member including a connecting portion and a guiding portion, wherein with said connecting portion adjacent the bone anchor said guiding portion extends proximally from said connecting portion and is adapted to receive the implant, said connecting portion including a body comprising a tapered portion forming a substantially uniform transition between the anchor and said guiding portion, wherein said guiding portion is structured to move between a loose condition and a taut condition. Support for the amendment to claim 10 may be found, for example, in ¶ 34 of the specification of the application.

The Applicant submits that the features recited in amended claim 10 are not disclosed by the '028 reference and therefore respectfully submits that claim 10 is patentably distinguishable thereover. Accordingly, withdrawal of the rejection of claim 10 is respectfully requested. Moreover, each of dependent claims 11-20 is submitted as patentable for at least the reasons supporting the patentability of claim 10.

In specific regard to the 35 U.S.C. § 103 rejection of dependent claims 15-18, the Applicant submits that in order for an obviousness rejection to be proper, the combination of prior art references must teach or suggest all the claim limitations. Manual of Patent Examining Procedure (MPEP) §2142 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The features of amended claim 10 which are novel over the '028 reference are also not taught or suggested by the '244 reference. Therefore, the combination of references fails to teach or suggest all of the claim limitations of amended claim 10, rendering the obviousness rejection thereof improper.

However, additional reasons exist for the patentability of at least dependent claims 16-18. Claim 16 recites that the distal extensions each include an engagement portion extending therefrom engageable with the bone anchor. Claim 17 further defines the engagement portions as projecting laterally from the distal extensions and claim 18 defines the distal extensions as deflectable toward one another. The Applicant submits that the '244 reference fails to teach or

Response to non-final Office Action
Application Serial No. 10/645,457
Page 10 of 11

NOV 02 2006

suggest each of the features of claims 16-18. More specifically, claims 16-18 are supported as patentable at least for the reasons asserted above supporting the patentability of each of respective claims 7-9. Accordingly, these claims are further submitted as patentable over the '028 reference in view of the '244 reference.

New Claims 68-79

Claims 68-79 have been added. Independent claim 68 is directed to the subject matter of original claim 7, and is allowable at for the reasons claim 7 is allowable as discussed above. Claims 69-73 depend from claim 68 and are also allowable. Independent claim 74 is directed to the subject matter of original claim 16, and is allowable at for the reasons claim 16 is allowable as discussed above. Claims 75-79 depend from claim 74 and are also allowable.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that the Applicant's application is in condition for allowance with pending claims 1-20 and 68-79.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: Douglas A. Collier
Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
(317) 238-6333 voice